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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,881	03/15/2002	Howard Kaufman	MDS-030	5399

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PATENT ADMINISTRATOR
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EXAMINER

MISTRY, O NEAL RAJAN

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/099,881

Applicant(s)

KAUFMAN ET AL.

Examiner

O'Neal R. Mistry

Art Unit

2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 40-70.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: The response received on 2/03/06 has been placed in the file and was considered by the examiner. An action on the merits follows.

Response to Arguments

The arguments filed on 2/13/06 have been fully considered. A response to these arguments is provided below.

Summary of Arguments:

1. Applicant alleges that Balas in view of Hochman does not disclose determining a measure of dynamic similarity between two selected regions of tissue and, thus, does disclose step (c) with respects to claims 40, 56, & 70.
2. Applicant alleges that Balas in view of Hochman in further view of Thirion does not disclose merging two regions into a single region if the measure of similarity satisfies a predetermined criterion, with respects to claims 41 & 57

Examiner's Response:

With respect to paragraph 1, the examiner respectfully disagrees. Balas in view of Hochman does disclose determining a measure of similarity between two selected regions of the tissue (col. 6 lines 10-12), the measure of similarity indicating how similarly tissue in each region responds to the chemical agent (col. 6 lines 13-15). The examiner interprets that Balas in view of Hochman discloses a method that compares the region of interest that is normal to a region of interest that is abnormal. The examiner interprets that the comparing is the same as finding similarities indirectly. The system takes the normal image and turns it into the background of the image, and then takes the suspected abnormal image as the foreground and compares the two images by taking the difference. If the two images have a lot of differences between the background and foreground, the region of interest within the image may contain tissue, which is malignant or cancerous. If the difference between the background and foreground is very minimal, the test results of the region of interest of patient's image by indicate that all tissue samples are healthy, and there is no trace of malignant or cancerous tissue. Therefore, the examiner interprets that the system is finding the similarity between two selected regions of the tissue, and in addition measures the similarity of the two region of interest. In addition, the similarity is determined after the chemical agent is applied to the patient (col. 6 lines 13-15), as stated by Hochman.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Balas in view of Hochman would be to improve the detection of tumors quickly for patients by reducing the amount of time the patient spends in the hospital (col. 2), as taught by Hochman.

With respect to paragraph 2, the examiner respectfully disagrees. Balas in view of Hochman in further view of Thirion discloses merging two regions into a single region if the measure of similarity satisfies a predetermined criterion (col. 6 lines 20-60). Thirion discloses this method of taking two image sets (col. 6 line 20-30), and then re-sample the data set to register them together to create a new third data set (col. 6 lines 48-55). The examiner interprets this to be the merging of two regions into a single region. Thirion does this method to allow the system to find similarities as well as differences between the images to detect any malignant or cancerous tissue.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Balas in view of Hochman in further view of Thirion would be to improve the accuracy of measuring change between the images over a change in time, and improve the system to determine the contrast in the changing images (col. 1 line 65-col.2 line 24), as taught by Thirion.


KANJIBHAI PATEL
PRIMARY EXAMINER